



Attorney Docket No. T9539.B

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: RANCE W. SEARLE et al.)
TITLE: HIGH DENSITY PLANTER)
SERIAL NO.: 10/669,157) REPLY BRIEF UNDER 37
FILED: September 22, 2003) C.F.R. § 41.41
EXAMINER: A. Valenti)
ART UNIT: 3643)

Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Sir:

This Reply Brief Under 37 C.F.R. § 41.41 is filed in response to the Examiner's Answer mailed October 14, 2005.

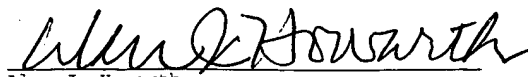
I. RESPONSE TO EXAMINER'S ANSWER

A. When the Cited References Are Considered in Their Entireties, They Do Not Teach or Suggest the Presently Claimed Invention.

The Examiner's Answer stated: "Khoury was cited to teach the structure of the container (see attached Australian Patent to

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Khoury) and Rolfe was cited to teach the known feature of attaching two containers together." This statement summarizes a critical error that has continued throughout the examination of this application. Namely, under the law of nonobviousness, references are to be considered in their entireties. *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 199 (Fed. Cir. 1983). When considering a reference in its entirety, it must also be considered for disclosures that teach away from the invention as well as disclosures that might direct one to the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 U.S.P.Q. 657, 669 (Fed. Cir. 1985). However, the Examiner has failed to carry out this essential approach to patent examination, because she has cited Khoury for the structure of the container and Rolfe for teaching attaching two containers together, while ignoring the other teachings of the references. This is an inappropriate approach to making a determination under 35 U.S.C. § 103.

When the cited references are considered in their entireties, the combination of Khoury and Rolfe does not lead a person of ordinary skill in the art to the presently claimed invention. It is not clear what the combination of Khoury and Rolfe leads to, but it is not the presently claimed planter.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Rolfe discloses making enclosed cubic containers. Enclosed containers would be inappropriate for use as planters, because such enclosed containers would not permit sunlight to reach the plants, and would not permit water to drain from the soil, among other liabilities.

Applicants respectfully submit that when the cited references are considered in their entirety, there is no suggestion that leads a person of ordinary skill in the art to the presently claimed invention.

B. Rolfe Is Non-analogous Art, Not Prior Art.

The Examiner's Answer alleged that both Khoury and Rolfe relate to the same field of endeavor, containers. Applicants respectfully submit that sandwich bags and weather balloons are containers, too, but they do not relate to the same field of endeavor. Khoury is in the field of fruit and vegetable crates. Rolfe is in the field of road transportation of freight. A person of ordinary skill in the art would not look to the field of transportation of freight to find the answer to a question relating to planters.

When Rolfe is excluded from consideration because it is non-analogous art, there is no reference or combination of references

that teaches each and every limitation of the presently claimed invention.

C. Examination Has Inappropriately Relied on Hindsight.

The Examiner's Answer relied on *In re McLaughlin*, 443 F.2d 1392, 170 U.S.P.Q. 209 (CCPA 1971), as support for the proposition that hindsight reconstruction is permissible in making a determination under Section 103 so long as "only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made" is taken into account and does not include "knowledge gleaned only from the applicant's disclosure."

In the first place, *McLaughlin* was a case where the appellant argued that references had been improperly combined to attempt to establish a *prima facie* case of obviousness. The court found that there was sufficient motivation in the prior art to make the combination of references. In *dictum* the court made the statement that the Examiner's Answer referred to about hindsight. Therefore, *McLaughlin* is *dictum* for the purpose for which the Examiner cited it.

In the second place, a few years later the C.C.P.A. stated in *In re Carroll*, 202 U.S.P.Q. 571, 572 (C.C.P.A. 1979):

One of the more difficult aspects of resolving questions of non-obviousness is the necessity "to guard against slipping into use of hindsight." *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 USPQ 459, 474 (1965). Many inventions may seem obvious to everyone after they have been made. However, 35 USC 103 instructs us to inquire

into whether the claimed invention "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

Moreover, it has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning led the Federal Circuit, in *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983), to state:

The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made.

Still further, the Federal Circuit stated as follows:

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 4225, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* Here, the prior art contains none.

Instead, the Examiner relies on hindsight in reaching his obviousness determination. But this court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore*, 721 F.2d at 1553, 220 USPQ at 312-13. It is essential that "the

decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596, 1599-1600 (Fed. Cir. 1988).

Examination of the present application has proceeded by picking and choosing containers from Khoury and attaching two containers together from Rolfe, while ignoring the other teachings of these references without the required motivation, incentive, or teaching to do so. This is examination by the inappropriate use of hindsight.

Applicants respectfully submit that if one follows the above guidelines and analyzes the art properly, then there is no suggestion of the invention as claimed.

Moreover, the choice of the phrase "within the level of ordinary skill in the art" again reveals that examination has not proceeded according to the appropriate standards for making a determination under Section 103. What is or is not within the level of ordinary skill in the art is not the standard by which an invention is to be considered. When the presently claimed invention is measured by the appropriate standard for making a determination under Section 103, the cited references do not render the presently

claimed invention obvious to a person of ordinary skill in the art at the time the invention was made.

II. CONCLUSION

Applicants respectfully request that the Board reverse the rejection of claims 1, 2, 4, 5, 7-10, and 13-24 under 35 U.S.C. § 103(a) over Khoury and Rolfe.

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Respectfully submitted,



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